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NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			UBER, NATHAN C	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/566,174	Applicant(s) FUNG ET AL.	
	Examiner NATHAN C. UBER	Art Unit 4143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :12 September 2006 and 27 January 2006.

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DETAILED ACTION

Status of Claims

1. This action is in reply to the filing of items required for a complete national stage entry application, those items filed on 12 September 2006.
2. Claims 1-36 are currently pending and have been examined.

Information Disclosure Statement

3. The Information Disclosure Statements filed 27 January 2006 and 12 September 2006 have been considered. Initialed copies of the Form 1449 are enclosed herewith.

Request for Information Under 37 CFR § 1.105

4. 37 CFR 1.105. Requirements for information.
 - (a)
 - (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:
 - (i) Commercial databases: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
 - (ii) Search : Whether a search of the prior art was made, and if so, what was searched.
 - (iii) Related information: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
 - (iv) Information used to draft application: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.
 - (v) Information used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.
 - (vi) Improvements: Where the claimed invention is an improvement, identification of what is being improved.
 - (vii) In Use: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

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(viii) **Technical information known to applicant . Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items.**

5. This is a request that applicants provide the information identified above especially where emphasis added. If applicants have this information, then applicants are required, under the provisions of 37 CFR 1.56, to disclose the information to the Office.
6. Applicant is not required or being asked to conduct a search for information beyond applicants own immediate files. If Applicant does not have immediate knowledge of the information requested, then a statement that the information sought is unknown or not readily available to the Applicant will be accepted by the office as a complete reply.
7. **Why the Request for Information is Reasonably Necessary:** Examiner identified an abstract of a press release dated 6 June 2002 on Applicant's website that announced an invention that appears to be the same as the invention that is the subject of Applicant's pending patent application. On Applicant's current website the abstract does not provide a link, however on an older version of Applicant's website (accessed through archive.org) the abstract supplied a link which Examiner believes may have lead to a more detailed press release. Due to the limitations of archive.org, Examiner could not follow the link. Please see the attached screen shot of the archive.org displaying applicant's website as of November 2002 (Attachment 1). Information about this publication and particularly its applicability to applicant's pending application is necessary for a determination of patentability under 35 U.S.C. 102.
8. **Information Requested of Applicants:** If Applicant possesses any of the information above, Applicant is required to send: publications of pertinent information as well as the dates of the aforementioned information.

Specification

9. The abstract of the disclosure is objected to because it contains self-evident clauses and it exceeds the word limit. Correction is required. See MPEP § 608.01(b).

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Claim Objections

10. Claims 23 and 24 are objected to because of the following informalities: the claims appear to be dependant on claim 1, however they lack a transition phrase such as "further comprising" indicating that they are proper dependent claims. Appropriate correction is required.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
13. Claims 1-19, 21-24, 28 and 32-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki (U.S. 6,129,274).

Claims 1, 33 and 35:

Suzuki as shown discloses the following limitations:

- *a plurality of electronic tokens for storing and processing token transaction data and token reward data, each of said electronic tokens for use by a respective user (see at least column 4, lines 16-17, smart card),*

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- *a computer server for storing and processing server transaction data and server reward data associated with each of said respective tokens (see at least column 12, lines 5-7, central computer system),*
- *a plurality of user interaction devices for communicating with said server, at least one of which is provided with a token acceptor device for reading from and writing to said tokens (see at least column 4, lines 39-42),*
- *wherein said server transaction data and said token transaction data are indicative of at least one transaction and said server and token reward data are indicative of rewards or entitlements earned or otherwise awarded (see at least column 4, lines 1-6, transaction history),*
- *said system is operable to transfer, for a respective token, server reward data from said server to said respective token and token reward data from said respective token to said server by means of said user interaction device provided with a token acceptor device (see at least column 4, line 39-54, transfers incentive indicia data),*
- *whereby said rewards or entitlements are redeemable either according to reward data stored on said token or according to reward data stored on said server (see at least column 7, lines 2-6).*

Claim 2:

Suzuki as shown discloses the following limitations:

- *said system is operable by each of said users 1) to transfer reward data from said server to a respective token of said respective user so that said respective user can redeem said rewards or reward points by presentation of said token (see at least column 7, lines 2-6, redeeming incentives and column 12, lines 1-7, batch processing with computer system),*
- *2) to transfer reward data from a respective token of said respective user to said server so that said respective user can redeem said rewards or reward*

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points by communicating with said server (see at least column 7, lines 2-6, redeeming incentives and column 12, lines 1-7, batch processing with computer system).

Claim 3:

Suzuki as shown discloses the following limitation:

- *each of said tokens is additionally adapted to store token user data pertaining to said respective user (see at least Figure 2, graphically identifying memory partitions on the token, and specifically user data).*

Claim 4:

Suzuki as shown discloses the following limitations:

- *said server is additionally adapted to store server user data pertaining to said respective user (see at least column 12, line 6, central computer system),*
- *said system is operable to synchronize said token user data with said server user data for a respective user when the respective token of said user is used with one of said user interaction devices having a token acceptor device (see at least column 12, lines 1-7, batch processing with computer system).*

Claim 5:

Suzuki as shown discloses the following limitation:

- *each of said tokens is any one of: a smart card, a chip in a mobile telephone, a chip in a personal digital assistant, a chip in a watch, and a chip in a key chain, wherein each of said tokens is operable to interact with said token acceptor device (see at least column 4, lines 16-17, smart card).*

Claim 6:

Suzuki as shown discloses the following limitation:

- *said transaction data includes, for each transaction, unique transaction identification data (see at least Figure 3).*

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Claim 7:

Suzuki as shown discloses the following limitation:

- *said system is operable to transfer data between said server and said tokens so that said system can reconcile said transaction data or said reward data (see at least column 12, lines 1-7, batch processing with computer system).*

Claim 8:

Suzuki as shown discloses the following limitation:

- *said user interaction devices are provided with processing software for recording said transaction data and said reward data relating to said transaction in said user interaction device, and to record said transaction data only in said tokens when said tokens are presented at said user interaction devices in the course of a transaction or activity (see at least column 12, lines 44-50, software “writes the transaction to the shopping history storage area of the IC card”).*

Claim 9:

Suzuki as shown discloses the following limitations:

- *said system is operable to transmit said transaction data and said respective reward data for each of said transaction rewards in said user interaction device to said server, and (see at least column 12, lines 1-7, batch processing with computer system),*
- *said server is operable to check said transaction data for duplicates, to discard duplicates, to record said transaction data that are not duplicated and to accumulate said respective reward data in said server reward data (see at least column 4, lines 40-42, capable of reading, writing and editing transaction data).*

Claim 16:

Suzuki as shown discloses the following limitations:

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- *at least one of said user interaction devices is equipped with a token acceptor device for retrieving said token transaction data from any of said tokens when said respective token is next used at one of said user interaction devices so equipped, and (see at least Figure 1),*
- *said respective user interaction device is configured to compute any rewards for a previous transaction (see at least column 12, lines 54-55),*
- *the resulting rewards data being sent to said server with said transaction data, whereby said server receives said transaction data and said reward data at least twice (see at least column 12, lines 1-7, batch processing with computer system).*

Claim 36:

Suzuki as shown discloses the following limitations:

- *at least one of said user interaction devices is equipped with a token acceptor device for retrieving said token transaction data and associated reward data from any of said tokens when said respective token is next used at one of said user interaction devices so equipped, and (see at least Figure 1),*
- *said respective user interaction device is configured to send to said server said transaction data and said associated reward data, whereby said server receives said transaction data and said reward data at least twice (see at least column 12, lines 1-7, batch processing with computer system).*

Claim 10:

Suzuki as shown discloses the following limitation:

- *said transaction or activity comprises any one of: a purchase transaction, a payment transaction, a cash withdrawal transaction, a transaction to consume or redeem an entitlement, a visit, a subscription to a service, a use of a service, a retrieval of information, a request for information, a submission*

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or provision of information, an application for membership, an access to a web page, a participation in an event, and a registration of a particular activity (see at least column 12, lines 38-39, sales transaction).

Claim 11:

Suzuki as shown discloses the following limitation:

- *each of said tokens is further adapted to store redemption data indicative of previously redeemed rewards or reward points (see at least Figure 2).*

Claim 12:

Suzuki as shown discloses the following limitation:

- *said user interaction devices are provided with processing software for computing an available balance of entitlements from at least some of said token transaction data, said redemption data, and said token reward data (see at least column 12, lines 54-55).*

Claim 13:

Suzuki as shown discloses the following limitation:

- *said user interaction devices are operable to display or print an available balance of entitlements (see at least column 6, lines 42-45, "creating a hard copy record on a printer").*

Claim 14:

Suzuki as shown discloses the following limitation:

- *said user interaction devices are operable to prompt a respective one of said users for an input indicative of whether said respective user wishes to redeem any reward according to an available balance of entitlements in an instant transaction (see at least column 13, lines 51-56).*

Claim 15:

Suzuki as shown discloses the following limitations:

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- *wherein said server is configured to receive transaction data from said tokens (see at least column 4, line 39-54, capable of reading transaction history from smart card),*
- *to compare said received transaction data with previously received transaction data (see at least column 4, lines 54-57, determine whether a customer deserves an incentive),*
- *to discard any duplicated transaction data, and (see at least column 4, lines 40-42, capable of reading, writing and editing transaction data),*
- *to form a reconciled set of transaction data wherein said reconciled set of transaction data constitutes said server transaction data (see at least column 12, lines 1-7, batch processing with computer system).*

Claim 17:

Suzuki as shown discloses the following limitation:

- *said system is configured to reconcile said token transaction data and said token reward data with said server transaction data and said server reward data when any of said respective tokens is used with a user interaction device provided with a token acceptor device for reading from and writing to said tokens (see at least column 12, lines 1-7, batch processing with computer system).*

Claim 18:

Suzuki as shown discloses the following limitation:

- *said system is configured to upload said token transaction data of a respective token to said server and thereby synchronize said respective token with said server, when said token is used with a user interaction device in online mode and provided with a token acceptor device for reading from and writing to said token, where said taken transaction data in said respective token had been added to said token when previously used with a*

user interaction device equipped with a token acceptor device, and where said token transaction data has not been previously transmitted to said server (see at least column 12, lines 1-7, batch processing with computer system).

Claim 19:

Suzuki as shown discloses the following limitation:

- *said server is configured to receive transaction and activity data corresponding to transactions or activities of a respective user on other business systems without using the respective token of said user, for determining rewards or entitlements to be awarded for said transactions and said activities, and recording the balance of such entitlements in said server reward data corresponding to said respective user (see at least column 12, lines 1-7, batch processing with computer system and column 8, line 67 to column 9, line 1, manually entering data).*

Claim 21:

Suzuki as shown discloses the following limitation:

- *wherein when said token reward data of a respective token is transferred to said server, said transferred token reward data is incorporated into said respective server reward data pertaining to said respective token, and removed from said respective token (see at least column 12, lines 54-55 and lines 63-66, "once incentive or loyalty points are calculated, the terminal adds...").*

Claim 22:

Suzuki as shown discloses the following limitation:

- *when said server reward data corresponding to a respective token is transferred to said respective token, said transferred server reward data is incorporated into said respective token reward data of said respective token,*

and removed from said server (see at least column 12, lines 54-55 and lines 63-66, "once incentive or loyalty points are calculated, the terminal adds...").

Claim 23:

Suzuki as shown discloses the following limitation:

- *for use by a plurality of Providers of goods, services or both goods and services (see at least column 5, lines 62-67).*

Claim 24:

Suzuki as shown discloses the following limitation:

- *for use by a plurality of groups of Providers, each group comprising one or more Providers, each of said groups providing a set of entitlements to said users, and each of said groups having its own set of business rules for awards and redemptions of entitlements, wherein reward data information of said set of entitlements is kept in each of said tokens and, for each of said set of entitlements, said server holds one set of offline reward data and one set of server reward data (see at least column 6, lines 15-21).*

Claim 28:

Suzuki as shown discloses the following limitation:

- *said system is configured to convert entitlement information awarded by a respective said user interaction device in a local currency to the currency of said respective token (see at least column 13, line 60, displaying the currency value of incentives/coupons on the card).*

Claim 32:

Suzuki as shown discloses the following limitations:

- *said transaction comprises an activity (see at least column 12, lines 38-39, sales transaction),*
- *said server transaction data comprises server activity data (see at least column 12, lines 38-39, sales transaction),*

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- *and said token transaction data comprises token activity data (see at least column 12, lines 38-39, sales transaction).*

Claim 34:

Suzuki as shown discloses the following limitation:

- *including additionally providing each of said tokens with token user data pertaining to said respective user (see at least Figure 2).*

Claim Rejections - 35 USC § 103

- 14.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 15.** The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

- 16.** Claims 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. 6,129,274) in view of Sehr (U.S. 5,566,327).

Claim 25:

Suzuki discloses the limitations as shown in the rejections above. Suzuki does not disclose transferring data between cards, however, Sehr, as shown, does:

- *wherein rewards can be transferred from a first of said tokens to a second of said tokens by transferring either token reward data or server reward data*

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from said first to said second token (see at least column 5, lines 26-29, a user may use a previous card and apply it/transfer it to a new card or may reuse an old card),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the transfer capabilities of the Sehr invention with the Suzuki invention because the Suzuki invention was contemplated as an improvement to the Sehr invention which operated "by means of a conventional cash-less payment methodology" (Suzuki, Column 3, lines 37-38), Suzuki was aware of the Sehr technology and indented to improve it by adding the functionality of collecting and storing customer transaction history (see background of Suzuki). Maintaining the ability to transfer information from one card to another may help prevent data loss if the card is damaged or lost, and help keep the cost of system maintenance and updates low.

Claim 26:

The combination Suzuki/Sehr discloses the limitations as shown in the rejections above. Further Sehr, as shown, discloses the following limitation:

- *said transfer is effected by means of one or more of said user interaction devices configured to transmit information about said transfer to said server for updating the server reward data corresponding to said first token and said second token (see at least Figure 2),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the transfer capabilities of the Sehr invention with the Suzuki invention because the Suzuki invention was contemplated as an improvement to the Sehr invention which operated "by means of a conventional cash-less payment methodology" (Suzuki, Column 3, lines 37-38), Suzuki was aware of the Sehr technology and indented to improve it by adding the functionality of collecting and storing customer transaction history. Maintaining the ability to transfer information from one card to another may help

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prevent data loss if the card is damaged or lost, and help keep the cost of system maintenance and updates low.

Claim 27:

Suzuki discloses the limitations as shown in the rejections above.

- *said user interaction devices are located in a plurality of countries, said countries collectively employ a plurality of currencies, and*

Suzuki does not disclose the location of any one user interaction device; however Examiner takes **Official Notice** that it is old and well known in that electronic systems may be adapted for use in multiple physical locations, including in different countries, as required by the purchaser of the system.

Suzuki does not disclose transacting in multiple currencies, however, Sehr, as shown, does:

- *said user interaction devices in each of said countries transact in a respective local currency, and wherein said tokens contain entitlement information based on said token reward data converted to the local currency of the respective user interaction device by said user interactive device or by said server so that an entitlement can be redeemed in a respective country (see at least column 5, line 20, the payment options include foreign currency),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to retain the foreign currency functionalities disclosed in the Sehr invention while endeavoring to improve the Sehr invention because the ability to transact in multiple currencies expands the personalization of the system and unites stores that perhaps have locations throughout the world for analytical purposes and/or customer service and prevents costly production of multiple versions of operating software to address multiple currencies by having on version that accommodates all currencies.

17. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. 6,129,274).

Claim 29:

Suzuki discloses the limitations as shown in the rejections above. Suzuki does not disclose the following limitations:

- *each group of a plurality of groups of Providers maintains in each of said tokens profile data relating to said respective group and of a user of said respective token, wherein a first of said groups of Providers can establish a business relationship with a second of said groups for the purpose of sharing the whole or parts of said profile data relating to said second Group, and ask a particular user at one of said user interaction devices of said first Group, during a transaction or activity, for permission to use said profile data for making an offer relevant to said respective user according to business rules encoded in said user interaction device, wherein user interaction device is provided with a token acceptor device for reading from and writing to said tokens and said user of said respective token can indicate consent by entering a password or PIN, which is used by said user interaction device to access said profile data.*

However Examiner takes **Official Notice** that it is old and well known in the art that *Providers* of incentive programs which are themselves collectors of purchase history and demographic information of customers may engage in cross promotional deals with other *Providers* and/or may sell or exchange accumulated customer information to other *Providers* for marketing purposes. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to enable customer information accumulated in the cards and on the servers to be accessed by *Providers* because *Providers* can use that information to improve their marketing tactics and will be more likely to participate in an incentive offering program if they could obtain data to demonstrate the successes and weaknesses of their marketing strategies.

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18. Claims 20 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. 6,129,274) in view of Freeman et al (U.S. 6,450,407).

Claim 20:

Suzuki discloses the limitations as shown in the rejections above. Suzuki does not disclose the following limitation, however, Freeman, as shown, does:

- *said system is configured to associate a respective username and password combination with each respective token, so that the respective user associated with said respective token can access said server reward data pertaining to said token by communication with said server and without said respective token (see at least column 10, lines 24-32),*

Freeman does not specifically show a username and password, however Freeman does disclose accessing the token and making changes using a variety of venues such as a personal computer and an ATM. Examiner takes **Official Notice** that it is old and well known in the art to use usernames and passwords or PINs when accessing sensitive information (i.e. personal financial information) using a personal computer and or an ATM. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to password protect access to the personal information gathered by the card in the Suzuki invention and to provide access via alternate means because having alternate access to the data on the card prevents data loss if the card is lost or damaged and password protecting the information ensures that the user's sensitive information will not be easily converted.

Claim 30:

Suzuki discloses the limitations as shown in the rejections above. Suzuki does not disclose the following limitation, however, Freeman, as shown, does:

- *said system is operable to allow a first of said users to leave a standing instruction recorded in said server to transfer entitlements from said server*

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reward data to credit a specified account (see at least column 10, lines 24-32, the rebate can be transferred by various methods),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the loyalty system of Suzuki with the rebate system of Freeman because many *Providers* prefer to provide cash incentives rather than coupons and the Suzuki invention would appeal to a wider audience of *Providers* and consumers if it was adapted to handle cash incentives.

Claim 31:

The combination Suzuki/Freeman discloses the limitations as shown in the rejections above. Freeman further discloses the following limitation:

- *said specified account is adapted to receive said transferred entitlements as payments of insurance premiums, for telecom bills, utility bills, outstanding loans or for other goods or services, the reward data of another set of entitlements of the same user or the reward data of another set of entitlements of another user, and said transfer can be effected on a regular basis or when a set of specified conditions are met* (see at least column 10, lines 24-32),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the transferability of Freeman with the Suzuki invention because this extends the utility of the Suzuki invention to *Providers* that may not have POS services or CID/TAD machines.

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Conclusion

19. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A Reagan** can be reached at **571.270.6710**.
20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
21. Any response to this action should be mailed to:

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22. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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/Nathan C Uber/ Examiner, Art Unit 4143

19 February 2008

/James A. Reagan/Supervisory Patent Examiner, Art Unit 4143